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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,937	10/21/2003	Luciano A. Gonzales	054034-1US (34111-0489)	4058
570 7590 01/14/2008 PANITCH SCHWARZE BELISARIO & NADEL LLP ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			EXAMINER UPTON, CHRISTOPHER	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/689,937	Applicant(s) GONZALES ET AL.	
	Examiner Christopher Upton	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 11-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 22-24, 26, 31 and 32 are rejected under 35 U.S.C. 103(a) as unpatentable over Bamer.

Bamer each disclose a containers having two layers of oil sorbing materials separated by permeable layers, as claimed. While Banner does not disclose the specific order of an adsorbent over an absorbent, it is submitted that Bamer discloses the use of both adsorbents such as diatomaceous earth, vermiculite, nylon, polypropylene and oyster shells as well as absorbents such as activated carbon, perlite, fibrous cellulose and cotton. It is submitted that one of ordinary skill in the art would obviously arrange

the specific materials in the most advantageous order, depending on the characteristics of the water and the expected contaminants to be treated, and that therefore, use of an adsorbent over an absorbent would have been an obvious configuration, absent a declaration showing unexpected results. With respect to the recitation of an oil containing vessel, it is submitted that this is intended use language failing to limit the claims.

3. Claims 1-8 and 22-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al.

Ross discloses a multi-layer filter having a fire retardant material (gravel) over an adsorbent (peat) and an absorbent (wood ash), and an aggregate (gravel), each of which is separated by a permeable geotextile membrane, as claimed. With respect to the recitation of an oil containing vessel, it is submitted that this is intended use language failing to limit the claims.

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Gannon ('639 or '390).

Claim 33 differs from Ross in recitation of positioning the containment basin beneath and around an oil containing vessel. It is submitted that it would have been obvious for one skilled in the art to adapt the separator of Ross to such a purpose, in view of the teaching of similar separators being so used by the Gannon patents.

5. Applicant's arguments filed on 11/29/2007 have been fully considered but they are not persuasive.

With respect to Bamer, applicant argues that Bamer does not disclose the specific arrangement of an absorbent below a layer of adsorbent material, and that the purpose is different. It is submitted that the disclosure of the wide variety of materials in Bamer would render the arrangement obvious for one skilled in the art, as one skilled in the art would seek to optimize the treatment by the arrangement of the bags. See column 4, lines 43-52, which discloses the arrangement according to selection by water condition, where the upper filter is selected to remove contaminants that would inhibit the ability of the lower media to remove contaminants. It is submitted that it would have been obvious for one of ordinary skill in the art to determine conditions where the upper selected material may be an adsorbent and the lower one an absorbent, given this teaching, absent a declaration showing unexpected results.

With respect to Ross, applicant argues that Ross only delays the passage of oil, but does not completely prevent it. It is submitted that complete prevention is not recited in the instant claims, and, in any event, would obviously depend on certain factors, such as the quantity of contaminant present and the amount of time that the filter has been in use. It is submitted that Ross discloses what is claimed by the applicant, a layer of an adsorbent, in the form of peat (see column 4, lines 59-61), over a layer of wood ash, which has absorbing properties (see column 5, lines 7-13).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Upton whose telephone number is

571-272-1169. The examiner can normally be reached on 8:30-6:00, off every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher Upton  
Primary Examiner  
Art Unit 1797